REMARKS

Claims 1-2 and 4-10 are currently pending in the application. No amendment to the claims have been made.

Claim 1 stands rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed.

The Examiner required that new drawings be submitted. Accordingly, attached herewith are four sheets of replacement drawings.

The Examiner submits that there is no support in the specification to show "that the inventor(s), **at the time the application was filed**, had possession of the claimed invention." (emphasis added) Specifically, the Examiner refers to the language of claim 1 "without the sender having knowledge of the unique carrier generated identifier." In response Applicants submit that claim 1 **as originally filed** includes the specific language above. Accordingly, this is proof positive that the inventors had possession of the claimed invention **at the time the application was filed.** Further, the Examiner is directed to the last 4 lines of paragraph 7 and lines 1-13 of paragraph 42 for additional support that the inventors had possession of the claimed invention at the time the application was filed.

Claims 1-2, 4-5, and 9-10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Bilibin (US Pub. No. US2005/0197892). This rejection is respectfully traversed.

Prior to discussing the rejection of record, a brief summary of the claimed invention and its advantages over the prior art is considered warranted. By way of background, the instant inventors observed that in many private and postal

carrier distribution systems a number of issues arise with respect to the ability of the sender of an item to track the item within the carrier's system. For example, since carriers typically track the item using a unique carrier assigned number that is applied by the carrier to the item, the sender must have some type of upfront communication with the carrier to obtain the unique carrier assigned number to permit inquiries by the carrier as to the tracking status of the item. Thus, the sender must either 1) physically bring the item to the carrier in order to receive the carrier's unique assigned tracking number, which may take a great deal of time, or 2) obtain such unique numbers from the carrier via some type of electronic communication such as the internet. However, while the online system helps minimize the time problem associated with physically bringing the mailpiece to the carrier, it creates another problem for the carrier in that the carrier cannot be sure that the unique carrier generated number was properly affixed to a specific item by the sender.

The instant inventors solved the above problem by using two unique identifiers: one **(13) (paragraph 0014, Fig. 1)** created by the sender and the other **(41) (paragraph 0019, Fig. 3)** created by the carrier. A user generates the unique sender identifier **(13)** during the creation of the mailpiece and submits it into the carrier distribution system, together with the item (i.e. mailpiece) without knowing anything else about the internal workings of the carrier's tracking system **(21)** (**Paragraph 0019, Fig. 4 step 42, Fig. 2) (inducting step of claim 1)**. The carrier obtains knowledge of the sender's unique identifier **(13)** by reading it off of the mailpiece **(Fig 4 step 43 and paragraph 0019) (obtaining step of claim 1)** and then associates the sender's unique identifier with the unique identifier **(41)** created by the carrier that the carrier uses to track the item **(Paragraph 0019) (assigning, associating and tracking steps of claim 1)**. Thus, when a sender wishes to check on the tracking status of their item, they only need to provide the sender's unique identifier to the carrier and they don't need to know anything about the carrier's unique identifier **(Paragraph 0024) (allowing step of claim 1)**. The carrier, via the created association between the sender's unique

identifier and the carrier's unique identifier, can identify the mailpiece and report the tracking status back to the sender **(Paragraph 0024) (providing step of claim 1)**. This system allows for a sender to, for example, drop a mailpiece into a carrier's drop box with a sender's unique identifier located thereon and still be able to track the mailpiece without receiving any unique identifier tracking information from the carrier **(Paragraph 0024).** The user (sender) does not have to go online or know anything about the carrier's system. The mailpiece itself is used as the vehicle to allow a carrier to obtain the sender's unique identifier and associate that sender unique identifier with a carrier unique identifier. The carrier is able to track the mailpiece using its unique identifier but to report the tracking status to the sender based on a sender request that only includes the sender unique identifier.

In Bilibin, a system 1 is used to receive information from a shipper(sender) about a package delivery. The system 1 assigns a system tracking number in its database that is associated with the package. That system tracking number is subsequently associated within the system 1 with a carrier tracking number obtained from the carrier for purposes of printing a shipping label for the package that would include the carrier tracking number. If a user enters a system tracking number into system 1, the system will associate the system tracking with the carrier tracking number so that the system can request a status update from the carrier **by sending a request to the carrier using the carrier's tracking number (0437).**

Thus, Bilibin is fundamentally different from the claimed invention in that it requires a sender to enter information into an online system and also requires that a shipping label (including the carrier's tracking number) be applied to the package by the sender. Both of these requirements reflect the very prior art problems the invention overcomes. By having the mail item include the unique sender generated identifier thereon, a sender can simply drop a mailpiece in a carrier's drop box and still trace the package without knowing the carrier tracking

number. There is no need to go online and thus if an individual does not have an online capability they can still track the package using their own unique identifier. The Bilibin apparatus simply does not teach or suggest such a capability.

Moreover, in the claimed invention the linking of the sender unique identifier and the carrier unique identifier is done during the processing of the mail item in the carrier distribution system which, of course, is required to permit the sender to simply drop the mailpiece in the drop box as described above. Bilibin does not teach that the carrier performs the linkage and in fact requires such linkage to be done prior to delivery into the carrier system since the shipping label with the carrier tracking number must be generated and applied to the mailpiece upon delivery to the carrier.

The Examiner submits that simply because Bilibin teaches a system tracking number and a carrier tracking number that are linked to each other, the claimed method limitations discussed above concerning that the mailpiece includes the sender unique identifier and that the carrier assigns the carrier unique identifier and links the carrier and sender unique identifiers during processing of the mailpiece in the carrier distribution would be obvious to one skilled in the art. Applicants traverse such position. As discussed above, these limitations provide a significant benefit that permits a sender to do nothing more than drop a mailpiece with a unique sender identifier in the carrier's drop box and still be able to track the mailpiece using only that sender unique identifier. Bilibin would not permit such a process to take place as it requires a user to enter information online and to apply the carrier tracking number to the mailpiece prior to processing by the carrier. These are the very prior art problems the invention (as described in the specification) overcomes.

Applicants submit that the Examiner's only support for saying that Bilibin renders the claimed method steps obvious comes from the Applicants' own specification. Such hindsight use of the Applicants' specification is not proper to establish a

prima facie case of obviousness. It is also very clear that the examiner has not pointed to something in the prior art that suggests in some way the proposed modification of Bilibin to arrive at the claimed invention. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting the combination. ***ACS Hospital Systems. Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)***

In view of the above it is submitted that the Examiner has not established a prima facie case of obviousness for claims 1-2, 4-5, and 9-10 based on the teachings of Bilibin.

Claims 4-5 and 9-10 stand rejected as being unpatentable over Bilibin in view of Wheeler (US Pub. No. US2002/0032623). Wheeler was cited in connection with the dependent claims for the purpose of teaching a unique ID tag. However, Wheeler does not correct the deficiencies of Bilibin discussed above and thus claims 4-5 and 9-10 are considered patentable over the combination of Bilibin and Wheeler. Additionally, applicants would like to point out that the examiner's position regarding claim 5 is improper since claim 5 is a method claim and not an **apparatus** claim. Accordingly, the positive recitation of using the unique sender generated identifier to locate the recipient address does patentably distinguish over the prior art which is void of teaching such step.

Claims 6-8 stand rejected under 35 U.S.C. 1029a) as being unpatentable over Bilibin in view of Park (Pub. No. US2001/0010334). Applicants submit that Park does not correct the above cited deficiencies of Bilibin and therefore claims 6-8 are patentable over the combination of Bilibin and Park based on their dependency from claim 1 and because of the inventive combination they make together with claim 1.

It is submitted, for the reasons set forth above concerning the deficiencies of the prior art, that the application stands in condition for allowance. Reconsideration of the rejections is respectfully requested and an early notice of allowance earnestly solicited.

Respectfully submitted,

/Steven J. Shapiro/
Steven J. Shapiro
Reg. No. 35,677
Attorney of Record
Telephone (203) 924-3880

PITNEY BOWES INC.
Intellectual Property and
Technology Law Department
35 Waterview Drive
P.O. Box 3000
Shelton, CT 06484-8000